

REMARKS

Claims 1-39 are all the claims pending in the application, with claims 1, 31, and 39 being the only independent claims. Applicant has presented a current claim listing for the convenience of the Examiner. No amendments to the claims are currently submitted. The foregoing amendment to the specification corrects an obvious error. No new matter is submitted.

Claims 1-23, 31-34, and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baudel et al. (5,666,499) in view of Barber et al. (5,586,243) and newly cited Meriaz (U.S. Pub. 2002/0113776). Claims 24-30, and 35-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baudel, Barber, and Meriaz, and further in view of assorted other references identified on pages 16-20 of the current Action. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Rejections under 35 U.S.C. § 103(a)

Claims 1-23, 31-34, and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baudel et al. (5,666,499) in view of Barber et al. (5,586,243) and newly cited Meriaz (U.S. Pub. 2002/0113776).

Claim 1 is directed toward a method for facilitating computer editing of an electronic document and recites “positioning a first cursor . . . responsive to user input from a first sensor associated with a user interface device” and “positioning a second cursor . . . responsive to user input from a second sensor associated with said user interface device.”

At least in part as an alternative to reliance solely on Baudel and Barber, the Office Action indicates that Baudel and Barber teach a number of claim limitations, except for the first and second sensors being associated with the same device (i.e., the user interface device) feature identified above. The Action attempts to remedy this deficiency of Baudel and Barber by relying upon Meriaz to teach this feature. Although the Action has combined Baudel, Barber, and Meriaz, Applicant asserts that the Office Action does not establish a prima facie case of obviousness. The basis for Applicant's position includes: (1) the alleged combination of references fails to teach or suggest several claim elements; (2) the proposed modification renders Baudel unsatisfactory for its intended purpose; and (3) Baudel's teachings lead one away from the claimed invention. Each of these positions will now be addressed.

1. Second cursor 401 is limited to tool palette 406

Claim 1 is directed toward a method for facilitating computer editing of an electronic document and recites “wherein said first and second cursors are independently displayable and independently positionable at any of said plurality of unique locations of said electronic document.”

Page 4 of the present Office Action addressed the claimed first and second cursor elements of claim 1. In particular, using Baudel, the Office Action equates primary cursor 402 with the claimed “first cursor” and secondary cursor 410 with the claimed “second cursor.” For the sake of argument, Applicant assumes that Baudel provides such description. Portions of Baudel which relate to these cursors are as follows:

“Fig. 4(a) illustrates a main application area 400 with only data and a primary cursor 402 (i.e., cursor controlled by primary pointer device 114) being shown on the display of graphics terminal 118.” (Col. 5, lines 42-45).

“As shown, an overly tool palette 406 is revealed at the current location of the primary cursor 402 of the current tool.” (Col. 5 lines 47-48).

“A secondary cursor 410 (i.e., cursor controlled by secondary pointer device 116) is displayed on tool palette 406 highlighting a selected tool.” (Col. 5, lines 50-53) (emphasis added).

The Examiner further commented in the Advisory Action of March 25, 2008, that overlay tool palette 406 is part of the main application area 400, and that overlay tool palette 406 is “not a different document.” Although Applicant respectfully disagrees with this characterization of the tool palette and Examiner’s characterization of Applicant’s specification, Applicant assumes *arguendo* the following:

- Main application area 400 discloses an electronic document;
- Overlay tool palette 406 is part of area 400 and forms part of the electronic document;
- Primary cursor 402 discloses the claimed “first cursor;” and
- Secondary cursor 410 discloses the claimed “second cursor.”

Even if these assumptions were correct, claim 1 is distinguishable over Baudel for the following reasons. Consider first, for the sake of argument, that primary cursor 402 is

positionable at any of a plurality of unique locations of an electronic document. In terms of Baudel, this would mean that primary cursor 402 is positionable at both main application area 400 and at overlay tool palette 406.

Consider next secondary cursor 410 (the claimed second cursor) which is described as being positionable only at overlay tool palette 406. Baudel describes this feature as follows:

“A secondary cursor 410 (i.e., cursor controlled by secondary pointer device 116) is displayed on tool palette 406 highlighting a selected tool. In the preferred embodiment, the secondary cursor 410 is a “block highlighting” cursor, constrained to being positioned on the bounding box of the currently selected tool on the tool palette.” (Col. 5, lines 52-55) (emphasis added).

The forgoing passage emphasizes that secondary cursor 410 is positionable only at tool palette 406. Since, in the Examiner’s construction, the overlay tool palette 406 comprises only a limited portion of main application area 400, secondary cursor 410 is positionable only at a limited number of locations of main application area 400 (i.e., those areas defined by overlay tool palette 406). This shortcoming results in secondary cursor 410 being positionable in only a limited number of locations of the electronic document (main application area 400). Claim 1 is quite distinguishable since it requires “said first and second cursors are independently displayable and independently positionable at any of said plurality of unique locations of said electronic document. This distinction is further illustrated in Figs. 5A-5C of Baudel.

2. Overlay Tool Palette 406 is not an electronic document

Claim 1 further recites “positioning a first cursor at a first location within said electronic document . . . [and] . . . positioning a second cursor at a second location within said electronic document . . .”

Applicant submitted comments with regard to this claim element in the last response of March 3, 2008. However, the Examiner did not deem such comments persuasive for the reasons set out in the Advisory Action of March 25, 2008. Applicant believes that the Examiner has misinterpreted the claims and specification of the present application, and in particular as they relate to the identified overlay tool palette 406 of Baudel. Applicant will first reestablish his position with regard to Baudel, and will then address the points raised by the Examiner in the

Advisory Action.

Page 4 of the present Office Action addressed the claimed first and second cursor elements of claim 1. In particular, using Baudel, the Office Action maintains the position of equating primary cursor 402 with the claimed “first cursor” and secondary cursor 410 with the claimed “second cursor.” For the sake of argument, Applicant assumes that Baudel provides such description. Portions of Baudel which relate to these cursors are identified in Point 1 above.

Applicant assumes again, *arguendo*, that main application area 400 of Baudel discloses an electric document, such that the displaying of primary cursor 402 (first cursor) on main application area 400 discloses “positioning a first cursor at a first location within said electronic document.” Even if this were true, claim 1 is distinguishable since secondary cursor 410 is not described as being displayed on application area 400. To the contrary, Baudel explicitly states that secondary cursor 410 is displayed on overlay tool palette 406. See also Fig. 4(b) of Baudel.

The distinction is that overlay tool palette 406 of Baudel is not an “electronic document.” Overlay tool palette 406 is simply a new object synthesis and existing object editing tool which permits a user to invoke and select operations on the content of an application. Indeed, Baudel emphasizes this point by stating that such tools (i.e., overlay tool palette 406) are tools “of an application.” (Col. 4, lines 24-25). It is understood that conventional tool palettes, which Baudel appears to describe, are in fact parts of applications (recall that Baudel explicitly makes this statement) which may be used to operate on the content of an electronic document active within the application. Such tool palettes are thus themselves simply not electronic documents. Thus, even if a cursor is positioned at a location within overlay tool palette 406, such teachings do not include positioning the second cursor at a location within the electronic document. The reason is clear; overlay tool palette 406 is not an electronic document, nor part of an electronic document – it is a native and intrinsic part of the software application user interface.

In contrast, recall that claim 1 requires that the positioning of the first and second cursors involve the same electronic document to the extent that claim 1 requires “positioning a first cursor . . . within said electronic document . . . [and] . . . positioning a second cursor . . . within said electronic document . . .”

The Baudel system, in contrast, describes displaying primary cursor 402 in application area 400, and displaying secondary cursor 410 on the completely different and completely

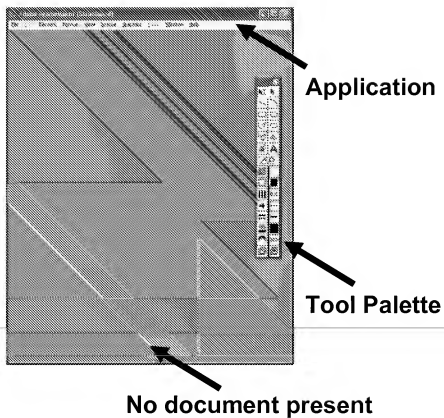
isolated area of the overlay tool palette 406. Baudel's overlay tool palette 406 is an overlay on the application area (Col.5 lines 47-48), not part of nor the same thing as application area 400.

And further, even assuming *arguendo* that overlay tool palette 406 and main application area 400 are both electronic documents, claim 1 is still distinguishable since they are not the same electronic document.

The Advisory Action commented on the forgoing by establishing two points. The first is that tool palette 206 is in the same "Application Area" space. Applicant believes that the Examiner's point is that overlay tool palette 406 and the data located in the whitespace region of application area 404 of Fig. 4B share the same "space" and therefore are the same "electronic document." Applicant respectfully disagrees for the following reasons.

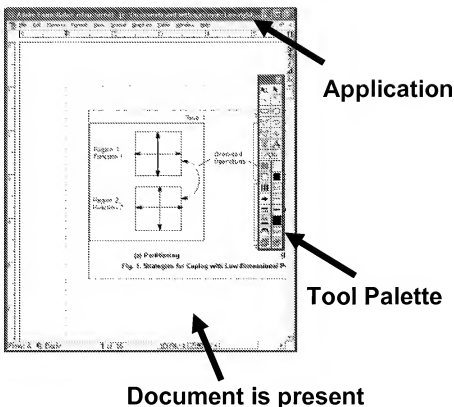
Applicant recognizes that Fig. 4B discloses application area 404 within which data, represented by assorted polygons, is present. However, Baudel goes on to state that tool palette 406 is an "overlay tool" that is revealed at a particular location of application area 400. (Col. 5, line 46). Even though the polygon data of Fig. 4B and tool palette 406 appears to visually share the same application area 400 (i.e., the same document), this is absolutely not the case since Baudel specifically states that tool palette 406 is an overlay to the main application area 404. Since tool palette 406 is an overlay, it cannot be the same electronic document as the polygon data of application area 404. To emphasize this point, Applicant provides the following two examples.

Example 1:



The foregoing first example relates to an application which does not have an electronic document currently open. In particular, the application is shown with a tool palette, but there is no electronic document present.

Example 2:



The foregoing second example relates to an application which does have an electronic document currently open. The application is shown with not only the tool palette, but an electronic document is shown as well. If two or more electronic documents were active in the application, the tool pallet would be unaffected. If any of the electronic documents are closed, the tool palette would still be displayed. If all of the electronic documents are closed, the tool palette would still be displayed. If yet another electronic document were then opened, the tool palette would still be displayed. This is because the tool pallet is part of the application, not part of the document. It just happens, in this case to be displayed over the document. Such properties of tool palettes are readily found endemically in commercial visual editing software applications.

In particular, Baudel chooses to require the overlay tool palette to be displayed in slight offset from the primary cursor (Col. 5 lines 47-48 and lines 59-64). This is why Baudel calls out his tool palette in fact and quite explicitly (Col. 5 lines 47-48) as an overlay tool palette.

The point is thus firmly established that a tool palette, such as that depicted in these examples and the one depicted in Baudel, are distinctly separate from the document that is present within the application. For these reasons, overlay tool palette 406 and the data of application area 404 are not the same electronic document, contrary to that set out in the Advisory Action.

Applicant next addresses the second point made in the Advisory Action, which is that Applicant's specification defines a drawing area that includes a tool bar. The Examiner points to Applicant's specification at page 34 line 8 through page 35 line 3, along with Fig. 7. Applicant recognizes that the cited passages and figure resemble Baudel's Fig. 4B, to the extent that both figures include an application, data, and tool bar or palette. However, this too is simply another overlay tool palette, which again is a standard graphical user interface feature paradigm in the software industry. Additionally, if necessary, Applicant respectfully points out that the cited portion of the specification relates to embodiments of the invention which are not presently cited in the rejected claim 1. Applicant instead invites the Examiner's attention to Section 3.9 of the present specification, which is set out at pg. 48 line 14 through pg. 51, line 4. This portion of the specification provides a non-limiting example of the embodiment of the invention presently recited in claim 1. Accordingly, reference to the Fig. 7 embodiment is not directly relevant to the present rejection. The point being that the Office Action has been employing an incorrect interpretation of an overlay tool palette, treating it as part of the document displayed in the application simply because (as an overlay must) it is directed overlaid on an underlying document.

Applicant has demonstrated in Points 1 and 2 that Baudel fails to teach or suggest the identified features of claim 1. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Baudel, Barber, and Meriaz in the manner asserted, claim 1 would be patentable since not all of the recited claim elements are taught or reasonably suggested. MPEP § 2143.

3. Proposed modification renders Baudel unsatisfactory for its intended purpose

Page 5 of the Office Action takes the following position:

“It would have been obvious to one of ordinary skill in the art, having the teachings of Baudel, Barber, and Meriaz before him at the time of the invention was made to modify the use of two different control devices to control two different pointers to locate both of the control devices in the same device. One would have been motivated to make such a combination because this allows for multidimensional control via one device controlled with one hand.” (Office Action, pg. 5) (emphasis added).

It is well established that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Applicant first submits that the changes to the Baudel system proposed by the Action would render Baudel unsatisfactory for its intended purpose. In particular, Baudel clearly states in the very first sentence of the abstract that its purpose is for enhanced user interaction with an application program utilizing “two-handed” techniques. The only embodiment described by Baudel involving two cursors relates to this “two-handed” technique.

This “two-handed” technique is one in which two different devices (i.e., devices 114, 116) are used for positioning two cursors (cursors 402, 410). (Baudel col. 5, lines 41-51; Fig. 2). Baudel further emphasizes that the predominant feature of its invention uses the two-handed technique, which requires the use of both devices 114, 116. Indeed, Baudel refers to the so-called “two-handed” technique on at least 16 different occasions. An example of Baudel’s insistence of the use of two devices in the “two-handed” technique is reproduced below:

“As will be apparent by the discussion below, a predominant feature of the invention is its conformity with how the user works cooperatively with both hands in the everyday world or “real domain.” That is, the user’s dominant hand is mainly used to control a primary cursor or tools, such as paint brushes, while the user’s non-dominant hand is generally used to control tool palettes.” (Baudel col. 4, lines 50-56). (Emphasis added).

Baudel therefore makes clear that its intended purpose is to permit a user to work with both hands. This is accomplished by using two different devices; namely, devices 114, and 116.

The modification proposed by the current Action is to modify the two input device of Baudel to include the one input device (purportedly having first and second sensors) of Meriaz. However, even if this modification were possible, it would completely destroy the entire purpose of Baudel. In particular, such modification would completely obviate the “predominant feature” of Baudel, which is to permit a user to use both hands to separately control two separate input devices. Since the proposed modification would utterly eliminate the “predominate feature” of Baudel, it would therefore render the Baudel system unsatisfactory for its intended purpose. In other words, if Baudel was modified to include first and second sensors in a single input device, the user would no longer be able to use both hands to separately control the user input devices. The proposed modification renders impossible the very feature that Baudel has so clearly described as being important. In such circumstances, MPEP § 2143.01 compels a finding that there is no suggestion or motivation to make the proposed modification to Baudel.

Applicant recognizes that Fig. 2 of Baudel depicts a “one-handed” operation module. However, this module is implemented only when two cursors are no longer desired. (Baudel col. 5, lines 10-11).

4. Baudel itself leads one away from a single input device

Once again, the modification proposed by the Action is to modify the two input device of Baudel to include a single input device according to Meriaz. However, in considering such a modification, one must look to the primary reference being modified to see what that reference describes with regard to such a modification.

In this regard, “[t]he totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness.” (MPEP 2145, citing *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)). In addition, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original)).

In this case, one must consider what Baudel describes with regard to the use of a single input device. This consideration is extremely relevant since, after all, this is the heart of the 35 U.S.C § 103 rejection of the current Office Action. In this regard, Baudel states that “one-handed” operation utilizes a single input device (conventional single pointer), which provides only a signal cursor. (Baudel, col. 5, lines 9-17). In other words, Baudel itself provides teachings relating to a modification from a two input device system to a one input device system. Such teachings unambiguously provide that this one input device system is used when a user no longer desires two cursors. To assert that the single input device of Baudel can be modified to include two sensors, as alleged in the Action, is to contradict the explicit teachings of Baudel, which is clearly improper according to MPEP § 2141.02.

In view of the foregoing, Applicant has proceeded contrary to that which is disclosed in Baudel, to the extent that claim 1 requires first and second sensors associated with the same device (i.e., the user interface device). MPEP §§ 2142.02, 2145 therefore compel a finding of nonobviousness of this claim in view of Baudel and Meriaz.

In summary, Applicant submits that that a prima facie case of obviousness has not been established since (1) the alleged combination of references fails to teach or suggest several claim elements; (2) the proposed modification renders Baudel unsatisfactory for its intended purpose; and (3) Baudel’s teachings lead one away from the claimed invention. For any or all of these reasons, it is believed that claim 1 is patentable over the cited references. Independent claims 31 and 39 include language similar to that of claim 1, and thus, are believed to be patentable for reasons similar to those discussed with regard to claim 1. The rejected dependent claims are believed to be patentable at least by virtue of their respective dependence on the patentable independent claims.

CONCLUSION

In view of the above, Applicant submits that the currently pending claims are in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone the undersigned so that such issues may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to deposit account No. 06-1135.

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